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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/517,612 | 12/22/2004 | Frederic Dolle | 263752US0PCT | 8512 |
| 22850 | 7590 | 01/17/2008 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER DAVIS, ZINNA NORTHINGTON | |
| | | | ART UNIT 1625 | PAPER NUMBER |
| | | | NOTIFICATION DATE 01/17/2008 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/517,612

Applicant(s)

DOLLE, FREDERIC

Examiner

Zinna Northington Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 11-19, 21, 23-26 and 43-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, 9, 20, 22, 27 and 29-42 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 6, 8, 10 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04/13/05 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-46 are pending.
2. In the response filed November 6, 2007, Applicants have elected, Group I, claims 1-10, 20-22, and 27-42, with traverse.
3. Applicants elect the compound of Example 7 as the preferred species.
4. Based upon the election of Group I, the election of the species requirement is withdrawn. However, the restriction requirement is maintained.

Response to Applicants Remarks about The Traversal of the Restriction Requirement

Applicants traverse the restriction requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups. Also, it has not been shown that a burden exists in searching the claims of the several groups.

It is the Examiner's position that:

- The methods of using the compounds of formula I are drawn to independent and patentably distinct subject matter. See claims 11 and 24, which discloses multiple uses, which are not related.
- Claim 26 is drawn to a method for medical imaging. There are known chemical compounds which are not structurally related to the claimed compounds which are useful in medical labeling. See Shiue (Reference AX) and Wilbur (Reference AW). Both references are cited by Applicants.

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- Under MPEP 806.05(h), the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. In this instance, the product as claimed can be used in a materially different process of using that product.
- The compounds of formula I are drawn to independent and patentably distinct subject matter.
- There is an undue burden is to search the entire scope of claims when multiple inventions are claimed.

Applicants state the claims of Groups VII to IX are directed to precursor compounds of the compounds which are used in the process of claim 27 for preparing the compounds of Formula (I). The precursor compounds include essential parts of the final structure of the compound of formula (I) and are used in essential steps of the process for preparing the compounds of formula (I).

It is the Examiner's position that:

- The precursor compounds are drawn to independent and patentably distinct compounds.
- If the compounds (claims 43-46) include essential parts of the process for preparing the compounds of formula (I), it is suggested that the precursor claims should be amended to read as dependent claims. However, the precursor compounds are claimed in the process claims of formula (I).

- The requirement is still deemed proper.
- The requirement is therefore made **FINAL**.

5. Claims 11-19, 21, 23-26, and 43-46 are withdrawn from consideration. These claims have not been canceled.

6. Rejoinder of the method claims will be addressed upon allowance of the claimed subject matter.

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3, 5, 7, 9, 20, 22, 27, and 29-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. At claim 1, it is suggested that the term "general" should be deleted.

B. At claims 1, 3, 5, 7, 9, 29, 33 and 34, the recitation of the phrases "such as" and "for example" is improper.

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C. At claims 20 and 22, what is intended by the term “macromolecule”?

At page 1, of the specification, macromolecules can include oligonucleotides, proteins, antibodies, and peptides. Clarification is appreciated.

D. Claims 29-35, 37, 39, and 41 are improperly multiply dependent

E. Claims 27, 29, 35, 37, 39, and 41 refer to 2 claim sets which is improper.

F. Claims 36, 38, 40, and 42 should end in a period.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 20 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No.10/518,382. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant compound of formula (I) is combined with a macromolecule.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 2, 4, 6, 8, 10, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Information Disclosure Statement filed April 13, 2005 has been considered. The references alone or in combination form do not teach nor suggest structurally similar compounds as the instantly claims compounds. There is no motivation to modify the compounds to derive those instantly claimed.

14. The International Search Report identifies two X references. It is the examiner's position that these references do not negate the patentability of the claimed compounds. Accordingly, no rejections based upon prior art are made.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

16. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
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